

REMARKS

Claims 26-51 are pending in the application.

Claims 26-51 have been rejected.

Claims 26, 27, 29, 30, 32, 35, 39 41, 45 and 51 have been amended, as set forth herein.

Claims 42, 49 and 50 have been canceled, without prejudice.

New Claims 52-54 have been added.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 26-30, 32-34 and 41-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nguyen (WO 97/098813). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

To further prosecution, Applicant has amended independent Claim 26 to further recite that the folio comprises a component housing insert for providing structural support and a binder for holding paper, and Applicant has amended independent Claim 41 to further recite a removable pocket configured to receive a personal computing device (PCD). Those additional claim elements/features are clearly not disclosed in Nguyen.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 26-30, 32-34 and 41-44.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 31, 35-40 and 45-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen (WO 97/09813) in view of Shink (US 5,348,347). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781,

783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to independent Claim 35, amended independent Claim 26 and amended Claim 41 (and their dependent claims), the Office Action concedes that Nguyen fails to disclose a binder for holding paper (see, Office Action, page 6) and a removable pocket configured to receive a personal computing device (PCD) (see, Office Action, page 5, discussing claim 31). The Office Action then argues that Shink teaches a pocketbook size organizer that can store a portable device, thus a person of ordinary skill in the art would combine Shink with Nguyen to come up with Applicant's invention as recited in the claims.¹ See, Office Action, pp. 5-6.

Nguyen discloses an integrated PDA-mobile telephone unit with no additional features or structure even relating to a day planner or folio. On the other hand, Shink merely discloses a conventional pocket organizer that includes straps for storing a cellular phone. Shink's phone does

¹ The Office Action also asserts that Nguyen discloses a "housing" (referring to Figures 1 and 2 of Nguyen), but this "housing" does not appear to be a component housing insert, as recited in Applicant's claims and described in Applicant's specification.

not electrically interface or wirelessly function with any other components of the pocket organizer. In distinct contrast, Applicant's day planner portfolio not only includes elements/structure of a folio or day planner, but further includes a wireless or wired system that includes an interface to a separate PCD (or other separate stand-alone device) and a wireless transceiver for wireless communication with another communications device. This enables the Applicant's day planner portfolio to provide (1) wireless communications/access between any stand-alone device (interfaced with the folio) and the remote communications device, (2) wired communication between the stand-alone device and the portfolio and wireless communication from the portfolio to the remote communications device, or (3) wireless communication between any stand-alone device and the portfolio and wired communication from the portfolio to the remote communications device. Notably, neither Nguyen or Shink provide the capability to wirelessly communicate data between a stand-alone remote PCD and the portfolio, as in one or more embodiments of Applicant's invention. Utilizing a physical connection in the interface to the PCD, the portfolio can also re-charge a battery of the PCD when the PCD is connected to the portfolio. It also provides the advantage of replacing both Shink's organizer and Nguyen's integrated PDA-mobile phone unit with a single portfolio operable with a stand-alone PCD.

Therefore, the Applicant respectfully submits that there is no suggestion or teaching to combine the Nguyen and Shink references², and even if combinable, the proposed combination does

² Though the Nguyen reference refers to the Shink reference on page 2, Nguyen further states that "Shink does not teach or suggest a personal communications terminal which can perform as a mobile telephone while transmitting, receiving, and displaying text." Nguyen, page 2, lines 26-29.

not disclose, teach or suggest the Applicant's claimed invention.

With respect to independent Claim 45 (and the dependent claims), none of the references, either alone or in combination, disclose, teach or suggest (1) a receptacle for holding a PCD where the receptacle includes a physical interface operable for interfacing electrically with an interface of the PCD, and (2) both a means for receiving data from a remote device and a wireless transceiver for communicating the received data to the PCD. Since Nguyen has an integrated PDA-phone unit, there is no need or teaching to communicate data wirelessly to its PDA 31. Further, Shink's organizer merely stores a conventional cellular phone 50. Thus, the proposed combination of Nguyen-Shink fails to disclose, teach or suggest Applicant's independent Claim 45 (and dependent claims).

With respect to dependent Claims 29, 33, 40, 44 and 52 (and any claims dependent therefrom), these claims recite a second wireless transceiver. Thus, these claims recite a device having both a first wireless transceiver and a second wireless transceiver. Neither Nguyen or Shink disclose, teach or suggest these elements, as recited in these claims.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 31, 35-40 and 45-51.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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